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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,984	12/22/2000	Leon Batachia	22097-003	4295
30623	7590	10/31/2003	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			FELTEN, DANIEL S	
		ART UNIT	PAPER NUMBER	
		3624		

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/746,984	Batachia et al
Examiner	
Friten	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12/22/2000.
 - 2a) This action is FINAL. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1 - 43 is/are pending in the application.
 - 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1 - 8, 10 - 35, 37 - 43 is/are rejected.
 - 7) Claim(s) 9 § 36 is/are objected to.
 - 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION

Drawings

- 1
2
3 1. This application has been filed with informal drawings which are acceptable for
4 examination purposes only. Formal drawings will be required when the application is allowed.
5

Claim Objections

- 6
7
8 2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the
9 original numbering of the claims to be preserved throughout the prosecution. When claims are
10 canceled, the remaining claims must not be renumbered. When new claims are presented, they
11 must be numbered consecutively beginning with the number next following the highest
12 numbered claims previously presented (whether entered or not). Misnumbered claims 43-61
13 have renumbered 25-43.

- 14
15 3. Claims 25-43 objected to because of the following informalities:

16 Re renumbered claims 26-32, 37, 39 and 42: Delete "...as in claim 43" and
17 substitute --...as in claim 25--.

18 Re renumbered claims 33-36 and 38: Delete "...as in claim 50" and substitute
19 --...as in claim 32--.

20 Re renumbered claims 40 and 41: Delete "...as in claim 57" and substitute
21 --...as in claim 39--.

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1 Re renumbered claim 43: Delete "as in claim 60" and substitute

2 --...as in claim 42--.

3 Appropriate correction is required.

4

5

6

7 ***Claim Rejections - 35 USC § 101***

8

9 4. 35 U.S.C. 101 reads as follows:

10 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any
11 new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this
12 title.

13

14 5. Claims 25-43 are rejected under 35 U.S.C. § 101, because the claimed invention is
15 directed to non-statutory subject matter.

16 The 35 U.S.C. § 101 statute requires that in order to be patentable the invention must
17 be "new and useful process, machine, manufacture, or composition of matter, or any new and
18 useful improvement thereof" (emphasis added). The use of the word "system" connotes
19 meaning(s) that embrace or overlap two different statutory classes of invention. Therefore it
20 is required of the applicant to state on the record the intention of claims 25-43 to be either
21 method claims or apparatus claims. For examination purposes, however, the examiner has
22 interpreted the "system" claims to convey the meaning of being apparatus claims.

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3 ***Claim Rejections - 35 USC § 102***

4 6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form
5 the basis for the rejections under this section made in this Office action:

6 A person shall be entitled to a patent unless -

7 (e) the invention was described in-
8 (1) an application for patent, published under section 122(b), by another filed in the United States before
9 the invention by the applicant for patent, except that an international application filed under the treaty
10 defined in section 351(a) shall have the effect under this subsection of a national application published
11 under section 122(b) only if the international application designating the United States was published
12 under Article 21(2)(a) of such treaty in the English language; or
13 (2) a patent granted on an application for patent by another filed in the United States before the invention
14 by the applicant for patent, except that a patent shall not be deemed filed in the United States for the
15 purposes of this subsection based on the filing of an international application filed under the treaty defined
16 in section 351(a).

17

18 7. Claims 1-3, 14, 15, 19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated
19 by Horstmann (US 6,285,985).

20

21 **Re claims 1 and 19:**

22 Horstmann discloses an offer and acceptance method and apparatus comprising:
23 generating an offer (advertisement), having means for generating an offer 105 (Ad
24 Module Builder Tool), based on policy (see Abstract); and pushing, having means for pushing,
25 the offer to a customer (see Horstmann, col. 4, ll. 27-40).

26

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1 **Re claim 2 and 20:**

2 Horstmann discloses receiving a customer request, with means for a customer to request the
3 offer (see Horstmann, "user initiated", fig. 6, col. 3, ll. 50+; col. 4, ll. 48+).

4

5 **Re claim 3, 14 and 22:**

6 Horstmann discloses wherein generating the offer further comprises: using an intelligent agent to
7 generate the offer (see Horstmann, col. 3, ll. 26-40); and wherein the offer generating means
8 further comprises: means for dynamically generating the offer (see Horstmann, col. 3, ll. 26-40)

9

10 **Re claim 15:**

11 wherein dynamically generating the offer comprises: using environmental parameters (see
12 Horstmann, col. 2, ll. 2-37).

13

14

15

16

17 ***Claim Rejections - 35 USC § 103***

18 8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
19 obviousness rejections set forth in this Office action:

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1 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
2 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
3 are such that the subject matter as a whole would have been obvious at the time the invention was made to a
4 person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
5 negatived by the manner in which the invention was made.

6
7 9. Claims 4-8, 10-13, 16-18, 20, 21 and 23-43 are rejected under 35 U.S.C. 103(a) as
8 being unpatentable over Horstmann (US 6,285,985) in view of Walker et al ("Walker",
9 6138,105).

10
11 **Re claim 4:**
12 Horstmann discloses wherein generating the offer with a plurality of options, but fails to disclose
13 an *offer package*.

14 Walker discloses a system which provides an offer package via a network to a POS for a
15 customer/consumer (see Walker, col. 2, ll. 47 to col. 3, ll. 9). Since the developer of Horstmann
16 has the ability of customizing offers to the user, it would have been obvious for an artisan at the
17 time of the invention to customize an offer package to the customer as an incentive for the
18 customer to buy a particular features for more money. Thus an artisan would have sought to
19 provide different package offers, based upon the customer profile and thus have been an obvious
20 expedient to one of ordinary skill in the art.

21

22

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1 **Re claim 5:**

2 Horstmann in view of Walker discloses wherein generating the plurality of options further
3 comprises: generating the options based on customer profile (see Horstmann, col. 2, ll. 2-37).

4

5 **Re claim 6 and 7:**

6 Horstmann in view of Walker wherein generating the plurality of options further comprises:
7 generating the options based on customer preferences (see Horstmann, Abstract, col. 2, ll. 2-37;
8 col. 3, ll. 62 to col. 4, ll. 17).

9

10 **Re claim 8:**

11 Horstmann in view of Walker wherein generating the plurality of options further comprises:
12 generating the options based on a customer's perceived value (see Horstmann, Abstract, col. 2, ll.
13 2-37; col. 3, ll. 62 to col. 4, ll. 17).

14

15

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18 **Re claims 10 and 27:**

19 Horstmann discloses policies, but fails to disclose wherein the policy is generated using a
20 revenue management policy. This is taught by Walker (see Walker, col. 2, ll. 28-33). It would

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1 have been obvious for an artisan of ordinary skill in the art at the time of the invention to employ
2 policies within Horstmann system based upon the theory of revenue management because an
3 artisan at the time of the invention would recognize the advantages of such policies to optimize
4 profits towards the supply and demand of time sensitive products. Thus such a modification
5 would reduce losses related to oversupplied or out of date products. Thus a modification would
6 have been an obvious expedient well within the ordinary skill in the art.

7

8 **Re claims 11 and 28:**

9 Horstmann discloses wherein the policy is generated using heuristics (see Horstmann, Abstract,
10 col. 2, ll. 2-37).

11

12 **Re claims 12 and 29:**

13 Horstmann discloses wherein the policy is generated using an expert system (see Horstmann,
14 Abstract, col. 2, ll. 2-37).

15

16

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19 **Re claim 13:**

20 wherein the policy is expressed in business rules (see Horstmann, Abstract, col. 2, ll. 2-37).

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2 **Re claim 16:**

3 wherein generating a plurality of offer packages, each offer package directed to a target
4 customer/customers (see Horstmann, col. 2, ll. 2-37).

5

6 **Re claim 17:**

7 Horstmann in view of Walker further comprising: receiving a customer's selection; and updating
8 a customer profile based on the selection (see Horstmann, col. 2, ll. 2-37).

9

10 **Re claim 21:**

11 Horstmann in view of Walker discloses further comprising means for generating the policy
12 coupled to the offer generating means (see Horstmann, col. 2, ll. 2-37).

13

14 **Re claim 23:**

15 Horstmann in view of Walker discloses further comprising means to transmit the offer to the
16 customer (see Abstract, Horstmann, col. 2, ll. 2-37).

17

18

19

20 **Re claim 25:**

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1 Horstmann in view of Walker discloses an offer and acceptance system comprising:
2 an offer package engine to generate an offer package based on policy; and
3 a business rules engine to supply business rules derived from the policy that is considered
4 in generating the offer package (see Abstract, Horstmann, col. 2, ll. 2-37; and explanation for
5 claim 4).

6

7 **Re claim 26:**

8 Horstmann in view of Walker further comprising: the offer package having a plurality of options
9 (see Horstmann, col. 2, ll. 2-37).

10

11 **Re claim 30:**

12 Horstmann in view of Walker discloses wherein the offer package engine is configured to push
13 the offer package (see Horstmann, col. 2, ll. 2-37).

14

15 **Re claim 31:**

16 Horstmann in view of Walker wherein the offer package engine is configured to receive a request
17 for the offer package (see Horstmann, “user initiated”, fig. 6, col. 3, ll. 50+; col. 4, ll. 48+; see
18 also explanation for claim 4).

19

20 **Re claim 32:**

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1 Horstmann in view of Walker a database to store a customer profile that is considered in
2 generating the offer package (see Horstmann, col. 2, ll. 2-37; see also explanation for claim 4).

3

4 **Re claim 33:**

5 Horstmann in view of Walker the customer profile includes a customer's perceived value that is
6 considered in generating the offer package (see Horstmann, col. 2, ll. 2-37).

7

8 **Re claim 34:**

9 Horstmann in view of Walker the customer profile includes a predicted behavior of a customer
10 that is considered in generating the offer package (see Horstmann, col. 2, ll. 2-37).

11

12 **Re claim 35:**

13 Horstmann in view of Walker the customer profile includes a customer preference that is
14 considered in generating the offer package (see Horstmann, col. 2, ll. 2-37).

15

16 **Re claim 37:**

17 Horstmann in view of Walker the offer package engine configured to dynamically generate the
18 offer package; and the business rules engine configured to cause the offer package engine to
19 dynamically generate the offer package based on environmental parameters (see Horstmann, col.
20 2, ll. 2-37).

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1 Re claim 38:

2 Horstmann in view of Walker the offer package engine configured to generate a plurality of offer
3 packages, each offer package is directed to a target customer/customers based on the customer
4 profile (see Horstmann, col. 2, ll. 2-37).

5

6 Re claim 18, 24, 39 and 43:

7 further comprising: an user interface to interact with customers (see Horstmann, col. 2, ll. 2-37).

8

9 Re claim 40:

10 further comprising: the user interface coupled to Internet (see Horstmann, col. 2, ll. 2-37).

11

12 Re claim 41:

13 Advertisements on a wireless network cell phones is known and can be used in conjunction with
14 the Internet to receive E-mail advertisements. Therefore Official Notice is taken of a wireless
15 network being an obvious extension to the teaching of Horstmann and Walker to advertise via
16 the Internet to a user.

17

18 Re claim 42:

19 the offer package engine having a system intelligent agent that generates an offer package (see
20 Horstmann, col. 2, ll. 2-37).

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3 ***Allowable Subject Matter***

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5 10. Claims 9 and 36 are objected to as being dependent upon a rejected base claim, but
6 would be allowable if rewritten in independent form including all of the limitations of the base
7 claim and any intervening claims.

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Conclusion

11. A list of relevant prior art appears below not relied upon in this Office Action:

3 **US Patents:**

4 Coueignoux (US 6,092,197) discloses a system and method for the secure discovery of
5 information

6 Walker et al (US 5,794,207) discloses a method and apparatus for conditional purchase offers

7 Walker et al (US 6,553,346) discloses conditional purchase offers management system for
8 packages

9 Walker et al (US 6,397, 193) discloses method and apparatus for automatically vending a
10 combination of products

11 12. Any inquiry concerning this communication or earlier communications from the examiner
12 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The
13 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.

14 Any inquiry of a general nature relating to the status of this application or its proceedings should
15 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
16 **Vincent Millin** whose telephone number is (703) 308-1065.

17
18 13. Response to this action should be mailed to:

19
20 Commissioner of Patents and Trademarks

21 Washington, D.C. 20231

22
23 for formal communications intended for entry, or (703) 305-0040, for informal or draft
24 communications, please label "Proposed" or "Draft".

25 Communications via Internet e-mail regarding this application, other than those under 35

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1 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
2 addressed to [daniel.felten@uspto.gov].

3
4 All Internet e-mail communications will be made of record in the application file. PTO
5 employees do not engage in Internet communications where there exists a possibility that
6 sensitive information could be identified or exchanged unless the record includes a properly
7 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
8 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
9 Trademark on February 25, 1997 at 1 195 OG 89.

10

11



12

DSF

13

October 22, 2003



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600